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PATRICK M DWYER PC
14419 GREENWOOD AVE N
BOX 322
SEATTLE, WA 98133

EXAMINER

SALLIARD, SHANNON S

ART UNIT	PAPER NUMBER
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3628

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10/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/057,048	Applicant(s) ROBERTSON ET AL.	
	Examiner SHANNON S. SALIARD	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 August 2008 has been entered.

Status of Claims

2. Applicant has amended claims 17, 20, and 22 and added claims 24-27. Claims 1-16 have been cancelled. Thus, claims 17-27 remain pending and are presented for examination.

Response to Arguments

3. Applicant's arguments filed 08 August 2008 have been fully considered but they are not persuasive.

4. Applicant argues, "Nowhere in Quackenbush is it taught that the Ground Delivery Operator has (1) a web site, (2) a server application to provide online service to users over the distributed network or (3) a luggage transport client application." However, Examiner disagrees. First, the Examiner has cited the Baggage Direct Website as being equivalent to Applicant's luggage carrier (see Fig., 3). Further, the Baggage

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Direct Website is a website of a luggage carrier which runs an application to provide online service to users over a network (see Fig. 3; col 3 ,lines 38-44), running a client application (col 3, lines 44-47; user provided option to arrange for pick-up and delivery; Examiner interprets a client application to be something that enables interaction between user and Baggage Direct website), and operatively connected to a luggage transport application (col 5, lines 30-50; manifest is created and sent to a GDO; Examiner interprets a luggage transport application to be something that enables interaction with between a luggage carrier and a luggage transport service) . Thus, Quackenbush et al's Baggage Direct and Airline Websites provide the same functionality as Applicant's luggage transport client application and carrier's application. Since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art, Applicant's invention is not patentably distinguished from Quackenbush et al, see *In re Dulberg*, 129 USPQ 348, (CCPA 1961).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 26-27** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 26-27 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying

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subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus the accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). While claims 26-27 identify an apparatus, nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. To permit such a practice would exalt form over substance and permit claim drafters to file the sort of process claims not contemplated by the case law. Cf., *Flook*, 437 U.S. at 593 (rejecting the respondent's assumption that "if a process application implements a principle in some specific fashion, it automatically falls within the patentable subject matter of § 101," because allowing such a result "would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for 'ideas' or phenomena of nature."). see *Ex parte Langemyr*. Since the use of apparatus is considered to be a nominal recitation of

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structure, and nominal recitations do not convert an otherwise non-statutory process into a process, claims 26-27 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 17-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Quackenbush et al [US Patent 6,512,964] in view of Lanigan, Sr. [US 2003/0061085] and Barni et al [US 6,920,429]

As per **claims 17 and 26**, Quackenbush et al discloses a system for providing pickup and delivery of luggage over a distributed network, the system comprising:

at least one computer server connected to the distributed network [see Fig. 3], the server running a luggage transport server application [col 3, lines 47-50, Examiner interprets an application to be something that enables interaction between user and website];

a plurality of user input/output devices operatively configured to access an online service at a service partner site [Fig. 3, col 3, lines 39-45];

the luggage transport server application operatively connected to data storage residing on computer readable media [Fig. 3, col 3, lines 50-54], and

the luggage transport server application configured to: receive and store luggage travel segment data from a user [col 4, lines 13-52, prompts user for location from which bags is to be picked up and delivered and database is updated].

Quackenbush et al does not explicitly disclose a plurality of luggage carriers each having sites, each luggage carrier's associated computer also running at least one luggage transport client application operatively configured to interact with the luggage transport server application.

However, Quackenbush et al discloses a service partner having a site, the site operatively associated with a computer connected to the distributed network, the service partner associated computer running at least one server application to provide online service to users over the distributed network [col 3, lines 46-55]. Furthermore, mere duplication of parts has no patentable significance unless a new and unexpected result is produced, see *In re Harza*, 124 USPQ 378 (CCPA 1960). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the luggage transport system of Quackenbush et al to include a plurality of luggage carriers each having sites and running a luggage transport client for a multiple effect and/or to accommodate all interested parties with no new and unexpected result.

Quackenbush et al does not further disclose programmatically match a luggage travel segment to a selected luggage carrier; output selected luggage travel segment data to the selected luggage carrier.

However, Lanigan, Sr. discloses that information from the passenger is transmitted to the central office of the luggage carrier (output segment data to service partner), which comprises a system different from the airline passenger system, for example United Parcel Federal Express, or another organization [0023; 0024]. Moreover, Barni et al discloses a customer may input a shipping lane and that available carriers for that shipping lane are identified and displayed ([col 5, lines 43-52]; Examiner interprets luggage travel segment to be a shipping lane). Barni et al further discloses that the website may be mirrored at additional servers in the network [col 4, lines 1-6]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Quackenbush et al to include the method disclosed by Lanigan, Sr. and Barni et al. Barni et al provides the motivation that it is highly desirable to provide an improved online business method wherein customers can obtain cargo rates from one or more freight forwarders without having to visit multiple third party sites and manually comparing the information during such searching [col 1, lines 52-66].

As per **claim 18**, Quackenbush et al does not disclose wherein the luggage transport server application is further configured to: receive and store luggage travel segment data from the selected luggage carrier; output luggage travel segment data to the user. However, Barni et al discloses that a carriers post published rates for transporting cargo and that a rate quote for a shipping lane is displayed to the user through the website [col 5, lines 15-30]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of

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Quackenbush et al to include wherein the luggage transport server application is further configured to: receive and store luggage travel segment data from the selected service partner; output luggage travel segment data to the user. Barni et al provides the motivation that providing this information to the customer allows them the opportunity to evaluate competitive prices in one consolidated location instead of having to navigate to individual company websites [col 5, lines 21-24].

As per **claims 19 and 27**, Quackenbush et al does not disclose wherein the luggage transport server application is further configured to: receive and store luggage travel segment bid data from the selected luggage carrier; output luggage travel segment bid data to the user; receive and store luggage travel segment bid acceptance data from the user; output luggage travel segment bid acceptance data to the selected service partner. However, Barni et al discloses that after a carrier has entered appropriate bid information, the bid is posted wherein the bid is displayed to the user and the user can accept the bid by highlighting the appropriate row in the table and then a conformation is sent to both parties [col 7, lines 12-54]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Quackenbush et al to include wherein the luggage transport server application is further configured to: receive and store luggage travel segment bid data from the selected service partner; output luggage travel segment bid data to the user; receive and store luggage travel segment bid acceptance data from the user; output luggage travel segment bid acceptance data to the selected service partner so that the user can receive the most competitive rates.

As per **claim 20**, Quackenbush et al discloses a system for providing pickup and delivery of luggage across multiple service providers over a distributed network, the system comprising: at least one computer server connected to the distributed network [see Fig. 3], the server running a luggage transport server application [col 3, lines 47-50, Examiner interprets an application to be something that enables interaction between user and website]; a plurality of user input/output devices operatively configured to access an online service at a service partner site [Fig. 3, col 3, lines 39-45]; the luggage transport server application operatively connected to data storage residing on computer readable media [Fig. 3, col 3, lines 50-54], and the luggage transport server application configured to: receive and store luggage travel segment data from a user [col 4, lines 13-52, prompts user for location from which bags is to be picked up and delivered and database is updated]. Quackenbush et al does not explicitly disclose a plurality of luggage carrier each having sites, each partner associated computer also running at least one luggage transport client application. However, Quackenbush et al discloses a service partner having a site, the site operatively associated with a computer connected to the distributed network, the service partner associated computer running at least one server application to provide online service to users over the distributed network [col 46-55]. Quackenbush et al does not further disclose programmatically match a luggage travel segment to a selected service partner; output selected luggage travel segment data to the selected service partner; receive and store luggage travel segment data from the selected service partner; and output luggage travel segment data to the user. However, Lanigan, Sr. discloses that information from the passenger is transmitted to

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the central office of the luggage carrier (output segment data to service partner), which comprises a system different from the airline passenger system, for example United Parcel Federal Express, or another organization [0023; 0024]. Moreover, Barni et al discloses a customer may input a shipping lane and that available carriers for that shipping lane are identified and displayed ([col 5, lines 43-52]; Examiner interprets luggage travel segment to be a shipping lane). Barni et al further discloses that the website may be mirrored at additional servers in the network [col 4, lines 1-6].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Quackenbush et al to include the method disclosed by Lanigan, Sr. and Barni et al. Barni et al provides the motivation that it is highly desirable to provide an improved online business method wherein customers can obtain cargo rates from one or more freight forwarders without having to visit multiple third party sites and manually comparing the information during such searching [col 1, lines 52-66]. Barni et al further discloses that a carriers post published rates for transporting cargo and that a rate quote for a shipping lane is displayed to the user through the website [col 5, lines 15-30]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Quackenbush et al to include wherein the luggage transport server application is further configured to: receive and store luggage travel segment data from the selected service partner; output luggage travel segment data to the user. Barni et al provides the motivation that providing this information to the customer allows them the opportunity to evaluate

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competitive prices in one consolidated location instead of having to navigate to individual company websites [col 5, lines 21-24].

As per **claims 21-23**, Quackenbush et al does not further disclose wherein the luggage transport server application is further configured to: programmatically match a luggage travel segment to a plurality of selected service partners; output selected luggage travel segment data to the plurality of selected service partners; receive and store luggage travel segment bid data from each service partner; output luggage travel segment bid data to the user; receive and store luggage travel segment's bid acceptance data from the user; output luggage travel segment's bid acceptance data to the plurality of service partners. However, Barni et al discloses a customer may input a shipping lane and that available carriers for that shipping lane are identified and displayed ([col 5, lines 43-52]; Examiner interprets luggage travel segment to be a shipping lane). Barni et al further discloses that after a carrier has entered appropriate bid information, the bid is posted wherein the bid is displayed to the user and the user can accept the bid by highlighting the appropriate row in the table and then a conformation is sent to both parties [col 7, lines 12-54]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Quackenbush et al to include wherein the luggage transport server application is further configured to: receive and store luggage travel segment bid data from the selected service partner; output luggage travel segment bid data to the user; receive and store luggage travel segment bid acceptance data from the user; output

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luggage travel segment bid acceptance data to the selected service partner so that the user can receive the most competitive rates.

As per **claims 24 and 25**, Quackenbush et al does not explicitly disclose further comprising the luggage transport server application being further configured to receive and store family member profile input and modification data from the user. However, Quackenbush et al discloses that a member may login to the baggage website to retrieve member information and create new transaction record (col 5, lines 13-52, Examiner interprets member login to retrieve info to mean that member profile is stored and updated). Furthermore, the difference between user profile information and family profile information are only found in the non-functional descriptive material and are not functionally involved in the steps recited. The receiving, storing and providing steps would be performed the same regardless of the descriptive material since none of the steps explicitly interact therewith. In other words, the family profile information would only mean something to a person monitoring the output after the final step of the method. Limitations that are not functionally interrelated with the useful acts, structure, or properties of the claimed invention carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would also have been obvious to a person of ordinary skill in the art at the time of applicant's invention to receive from a plurality of unrelated luggage carrier systems any type of data, storing the data, and providing the

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data to a user because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON S. SALIARD whose telephone number is (571)272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Randolph Building, 401 Dulany Street, Alexandria, VA 22314

Shannon S Saliard
Primary Examiner
Art Unit 3628

/Shannon S Saliard/
Primary Examiner, Art Unit 3628